

U.S. Patent Appln. No. 09/605,612
Response dated December 14, 2004
Final Office Action dated June 15, 2004
Docket No. BOC9-1999-0085 (142)

REMARKS / ARGUMENTS

These remarks are made in response to the Final Office Action mailed June 15, 2004. Applicants submit that their original reply to this Final Office Action was mailed via U.S.P.S. Express Mail No. EV 291962457 US on August 13, 2004 (the Submission). No Advisory Action has been issued or received in response to the Submission although the Submission was filed on or before two months after the issuance of the Final Office Action pursuant to MPEP 706.07(f). An appropriate fee for a time extension has been included.

After numerous calls to determine the status of the instant application, the undersigned instructed his secretary to call the Examiner to determine the status of the Examiner's review. The Examiner stated that the Submission had not yet been scanned into the system by the Electronic Business Center (EBC) and as such was unable to review the response. Accordingly, a telephone call was placed to the EBC to determine why the Submission which was filed on August 13, 2004, and for which a return postcard was received indicating it had been received at the USPTO on August 13, 2004, had not been scanned. The EBC had on that date a message stating that the EBC was in the process of moving.

As such, the undersigned telephoned the Examiner and resubmitted the Submission via facsimile transmission. As of this date, no Advisory Action has been issued, and as such this Request for Continued Examination is being filed pursuant to Applicants' duty to maintain the examination of the underlying application. This response which is now to be treated as a preliminary amendment for purposes of this RCE, introduces the 131 declaration and proof as to diligence.

In paragraphs 4 and 5 of the Final Office Action, claims 1-18 and 22-27 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,349,132 to Wesemann, et al. (Wesemann). The Patent Office previously refused to accept Applicants' affidavit under 37 C.F.R. § 1.131 submitted to show that the Applications' date of invention predates Wesemann. The refusal was based upon an allegedly insufficient showing as to conception and diligence.

In response, the Applicants herein re-file an affidavit under 37 C.F.R. § 1.131 showing the Applicants' date of invention predates Wesemann. The affidavit is accompanied by a copy of the Applicants' confidential invention disclosure numbered BOC8-1999-0113 entitled "Method

and Apparatus for Synchronized Voice and Visual User Interface Access to Internet Web-Based Information". The confidential invention disclosure and affidavit demonstrated proof of conception for the claimed subject matter of the Applicants' invention at least as early as November 11, 1999, which predates the December 16, 1999 filing date of Wesemann.

The Disclosure is a completion of an International Business Machines Corporation (IBM) confidential disclosure form, which is a standardized document utilized by the IBM and submitted by the inventors upon conception of an invention. The document management system under which the IBM confidential disclosure form has been generated does not permit amendments to be made to the Disclosure once the Disclosure has been completed. Any changes and/or additions are appended as an attachment to the IBM confidential disclosure form together with the date the attachment was added. No such attachment accompanies the Disclosure, signifying that the Disclosure has not been amended since November 11, 1999.

The IBM confidential disclosure form provides all information necessary for outside legal counsel to prepare an appropriate patent application relative to the disclosed invention when used in conjunction with information known by one of skill in the art. The present application, including each claim within the present application, has been prepared based upon the Disclosure. No additional information was relied upon other than the Disclosure and the Patent Attorneys' general knowledge of patent drafting and technical knowledge possessed by one of ordinary skill in the art in transforming the Disclosure into the present application.

Further, as noted in the enclosed Declarations, prior to submission of the application to the USPTO, the inventors review the application to insure that the claims and material contained therein are fully supported by the Disclosure. The inventors performed such a review and swore to the same for the present application.

Applicants further exercised due diligence from prior to the effective date of Wesemann until June 28, 2000, the filing date of the instant application. In regard to diligence, as set forth in the Declarations, once an IBM invention disclosure form is completed, the disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application, instructions in this regard,

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together with the IBM invention disclosure form, are conveyed to the outside counsel. The outside counsel prepares a draft of the application that is iteratively reviewed by each inventor until such time that the inventors are satisfied that the application sufficiently details the inventive concepts detailed in the disclosure, at which time the application is expeditiously filed with the USPTO.

Since Applicants conceived of the present invention before the effective date of Wesemann and exercised due diligence in constructively reducing the invention to practice between the date of the Disclosure until the filing date, as supported by the enclosed Declarations, Wesemann should be withdrawn as a reference for purposes of 35 U.S.C. § 102. Consequently, the rejections to claims 1-18 and 22-27 under 35 U.S.C. § 102(e) based upon Wesemann should be withdrawn, which action is respectfully requested.

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Dated: 14 Dec 2004



Gregory A. Nelson, Reg. No. 30,577
Brian K. Buchheit, Registration No. 52,667
AKERMAN SENTERFITT
Customer Number 40987
P.O. Box 3188
West Palm Beach, FL 33402-3188
Tel: 561-653-5000